

Docket No.: 9369-119US(U01-191290C/KK)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yoshio ASAKURA et al.

Application No.: 10/596,242

Confirmation No.: 4058

Filed: June 6, 2006

Art Unit: 1796

For: VINYL-CIS-POLYBUTADIENE RUBBER
AND BUTADIENE RUBBER COMPOSITION
USING THE SAME

Examiner: N. M. Nutter

SUBMISSION UNDER 37 C.F.R. § 1.312

The undersigned thanks the Examiner for the various recent telephonic conversations between the undersigned and the Examiner regarding the consideration of prior art filed in Information Disclosure Statements.

Applicants hereby provide written details of certain prior art which was submitted in previous Information Disclosure Statements and which Applicants respectfully request be considered. Applicants note that every document in the attached Appendices has been obtained from PAIR, and is already part of the record of the present application, but is included herewith to facilitate the presentation of supporting evidence and for the convenience of the Examiner.

On June 6, 2006, an Information Disclosure Statement ("IDS") was filed in the U.S. Patent and Trademark Office ("USPTO"), a copy of which is attached hereto in Appendix A. The Information Disclosure Statement stated that "[t]he enclosed references were cited in a [sic] International Search Report (copy enclosed) dated April 5, 2005 from the Japanese Patent Office concerning counterpart International Application No. PCT/JP2004/018417 and/or in the Background section of the application." The Office Action dated December 1, 2008 included form PTO/SB/08a from the June 6, 2006 IDS, but Foreign Patent Documents 5-13 were not

considered by the Examiner with the notation “Japanese not from PCT 210.” The relevant portion of the form PTO/SB/08a is attached in Appendix A. Applicants respectfully note that Foreign Patent Documents 5-13 (copies attached in Appendix A) are cited in the Background Section of the present specification, as stated in the IDS. In particular, Applicants respectfully direct the Examiner to paragraphs [0006] – [0009] of the substitute specification (relevant pages attached in Appendix A). The disclosure in the Background section of the specification is sufficient to provide a concise statement of relevance for references in a foreign language. As stated in 37 C.F.R. § 1.98(a)(3)(i), “[t]he concise explanation may be either separate from applicant’s specification or incorporated therein.” Accordingly, Applicants respectfully request that the Examiner consider Foreign Patent Documents 5-13 from the IDS filed June 6, 2006.

On July 2, 2009, Applicants submitted a Supplemental IDS in the USPTO, which is attached herewith in Appendix B. In the Notice of Allowability, Foreign Patent Document 2 was not considered, and was labeled as “missing” in the form PTO/SB/08a, relevant pages therewith being included in Appendix B. However, Foreign Patent Document 2 (TW 475938) was submitted to the USPTO and a copy from PAIR is included herewith in Appendix B along with an English abstract and claims. Additionally, Applicants note that Foreign Patent Document 2 is a counterpart for U.S. Patent No. 6,300,450 (enclosed in Appendix B), which was already considered by the Examiner, so the consideration of Foreign Patent Document 2 is merely a formality at this point. Applicants therefore respectfully request that Foreign Patent Document 2 be considered by the Examiner.

In the Notice of Allowability, Non-Patent Literature Document 1 (Encyclopedia of Polymers) (see Appendix B) of the Supplemental IDS of July 2, 2009, was not considered and labeled as being in Russian with no translation in the form PTO/SB/08a (relevant pages attached in Appendix B). In the Supplemental IDS of July 2, 2009, Applicants stated that the Encyclopedia of Polymers was cited in a Russian Office Action issued on January 26, 2009 and that a concise statement of relevance for Encyclopedia of Polymers was also included. Applicants hereby include in Appendix B a copy of the Encyclopedia of Polymers, the Russian

Office Action (with translation), and the concise statement of relevance for Encyclopedia of Polymers, all of which have been obtained from PAIR. In view of the above, Applicants respectfully request that the Encyclopedia of Polymers be considered by the Examiner.

Applicants respectfully request that prompt notice be provided of the consideration of the above-identified prior art. Should the Examiner have any questions, the undersigned can be reached at 215-366-5280.

Dated: *Sep. 23, 2009*

Respectfully submitted,

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